

Notice of Allowability

Application No.

10/634,177

Examiner

Evelyn Huang

Applicant(s)

WILSON, MICHAEL WILLIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to reponse filed on 9-27-2004.
2. ☒ The allowed claim(s) is/are 2-8 and 11-13.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Purchase on 12-6-2004.

During the interview, the examiner rejoined the withdrawn method claims 8-13 having the scope of the allowable compound claims 2-7.

The examiner suggested deleting the thiazolo[3,2-a]pyridine compounds from claim 7 since they have no antecedent basis in the base claim 2, which is directed to thiazolo[3,2-a]pyridine compounds. The examiner also suggested amending claims 5, 8, 11, 13 to better define the claims to place the application in conditions for allowance.

The application has been amended as follows:

- a. Claim 5, replace '4 Claims 2-4' with – Claims 2-4 --.
- b. Claim 7, page 9, delete the following compounds:
'6-(3,4-difluoro-benzyl)-8-methyl-5,7-dioxo-6,7-dihydro-5H-thiazolo[3,2-a]pyridine-2-carboxylic acid benzylamide,
6-(3,4-difluoro-benzyl)-8-methyl-5,7-dioxo-6,7-dihydro-5H-thiazolo[3,2-a]pyridine-2-carboxylic acid (pyridin-4-yl-methyl)amide, and
6-(3,4-difluoro-benzyl)-8-methyl-5,7-dioxo-6,7-dihydro-5H-thiazolo[3,2-a]pyridine-2-carboxylic acid (2-methoxy-pyridin-4-yl-methyl)amide,'.
- c. Claim 8,
 - Delete 'for the treatment of a condition selected from the group consisting of connective tissue disorders.....and cancer in a mammal, including a human'.

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- Replace 'comprising an amount of a compound of Claim 2, or a pharmaceutically acceptable salt thereof, effective in such treatment and a pharmaceutically acceptable carrier' with the following :
 - comprising a compound of Claim 2, or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier --.
- d. After claim 8, insert – Claims 9-10 (canceled) --.
- e. Claim 11, delete – according to claim 8, --.
- f. Claim 13, replace 'according to claim 12, wherein the compound administered is' with -- for treating arthritis, comprising administering to a patient suffering from an arthritis disease a nontoxic antiarthritic effective amount of --.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

Claims 2-8, 11-13 are allowed.

The rejection for Claim 2 under 35 U.S.C. 112, second paragraph is withdrawn because the amendment has obviated the rejection.

The rejection for Claims 1, 6 under 35 U.S.C. 102(b) as being anticipated by Harris R.L.N. (Australian Journal of Chemistry (1972), 25(5):993-1001, PTO-1449) is withdrawn in view of the cancellation of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the prior art thiazolo pyridine compound.

The rejection for Claims 1, 6 under 35 U.S.C. 102(b) as being anticipated by Galera et al. (Journal of Heterocyclic Chemistry (1986), 23(6): 1889-92) is withdrawn in view of the cancellation of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the prior art thiazolo pyridine compound.

The rejection for Claims 1, 6 under 35 U.S.C. 102(b) as being anticipated by Diaz et al. (Journal of Organic Chemistry (1994), 59(26): 8294-96) is withdrawn in view of the cancellation

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of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the prior art thiazolo pyridine compound.

The rejection for Claims 1, 6 under 35 U.S.C. 102(b) as being anticipated by Kim D.G. (Chemistry of Heterocyclic Compounds (New York)(Translation of Khimiya Geterotsiklicheskikh Soedinenii) (1999), 35(3), 290-292) is withdrawn in view of the cancellation of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the prior art thiazolo pyridine compound.

The rejection for Claims 1-6 under 35 U.S.C. 102(e) as being anticipated by Bunker (US 2003/0144274) is withdrawn in view of the cancellation of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the prior art thiazolo pyridine compound.

The provisional rejection for Claims 1-6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-17 of copending Application No. 10/264764 is withdrawn in view of the cancellation of claim 1 and the amendment limiting the claims to thiadizolo[3,2-a]pyridine compounds, thereby setting a demarcation from the copending thiazolo pyridine compound. Motivation to modify the copending compound to arrive at the instant invention is lacking.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Evelyn Huang", is positioned above the printed name.

Evelyn Huang

Primary Examiner

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